

REMARKS

At page 2 of the above-referenced Office Action, claims 1-12, 16, 17 and 19-21 are rejected under 35 U.S.C. §102(b) as being anticipated over Osborne ('640). Various other rejections follow and will subsequently be discussed. However, it is to be noted that claims 19 and 20 were rejected as being anticipated under 35 U.S.C. §102(b) by Osborne in an Office Action mailed 5/23/2002. In responding to that rejection applicant therein noted as follows:

Rejection of Claims 19 and 20 over Osborne

Claims 19 and 20, after amendment, require that the core wire comprise "multiple, randomly-disposed non-metallic fibers and a binder resin..." In contrast, Osborne discloses, for example as depicted in Figure 1, that the core wire includes a "set of fibers 12 which are arranged substantially parallel to the longitudinal axis..." See col. 2, lines 30-36 and lines 48-51. This disclosure of parallel, longitudinally-oriented core fibers clearly does not anticipate claims directed to randomly-disposed core fibers, as described in the present application. Thus, Osborne does not anticipate claims 19 and 20.

In light of the above, it is respectfully submitted that claims 19 and 20 are not anticipated by Osborne. Withdrawal of the rejection is respectfully requested.

Clearly, claims 19 and 20 already have been rejected over this reference early in the prosecution of the same application. No new analysis or re-interpretation of Osborne '640 is included in the 11/24/2003 Office Action. For the same reason stated above, it is believed that claims 19 and 20 are neither anticipated nor rendered obvious by the disclosure of Osborne '640. Thus, withdrawal of this rejection and indication of allowable subject matter in claims 19 and 20 is respectfully requested.

Perhaps more importantly, the remaining pending claims 1-12, 16, 17 and 21 were clearly examined over the Osborne '640 patent earlier in prosecution of this application. No rejection under 35 U.S.C. §§102 or 103 were raised. For a rejection to be raised at this late juncture is completely contrary to the Manual of Patent Examining Procedure which indicates that the goal of examination is clearly to articulate any rejection early in the prosecution process. (See the Manual of Patent Examining Procedure §706). Moreover, the Obsorne '640 patent is cited and

discussed at page 2 of the present disclosure. For the Office to now take the position that the Osborne '640 patent now anticipates and renders obvious claims which were clearly drafted in view of that reference would appear to be inconsistent with the Manual of Patenting Examining Procedure noted above.

Claim 1, and all pending claims of the present application require the guidewire to be "non-metallic". This term is defined at page 4 of the Specification:

"...to mean containing and comprising no metals, alloys or other materials which respond in some manner to the magnetic or radio frequency fields generated in an MR imaging system. This definition is intended to exclude any non-ferrous metals which, while not necessarily interacting with the MR magnetic fields, exhibit what has become known as "antenna effect" by interaction with the radio frequency fields used in that procedure. Thus magnetic field deflection and "antenna effect" are completely eliminated by the use of the present invention." (Specification page 4, lines 9-17).

Osborne '640 also clearly does not recognize the problem(s) solved by the present invention relating to antenna effect and magnetic field deflection. No mention of either problem is made in the Osborne '640 patent. It would be very surprising for a reference which does not appreciate or even mention any of the problems solved by the present invention to anticipate it.

Moreover, at column 5 starting with line 34 it is noted:

"The present invention also contemplates various hybrid structures in which a metallic mandrel of the types well known in the art is included as a central core about which groups of fibers are attached and/or wrapped around the mandrel and then imbedded in an epoxy matrix. A cross-section of such a hybrid is shown in Fig. 8. In this case shaft 70 includes a nitinol central core 71, concentrically surrounded by fiber layers 72 and 73, which are embedded in an epoxy matrix..." (emphasis supplied).

Thus, that aspect of the Osborne '640 patent disclosure also is precluded by the requirement of all claims of the present application that the guidewire be "non-metallic."

Significantly, Osborne '640 discusses at length the "composite wire guide" which is their alleged invention. A "wire guide" clearly suggests to one skilled in the art the presence of metallic structures.¹ No hint or suggestion is made anywhere in Osborne '640 that the advantages of applicant's completely non-metallic guidewire structure could be obtained.

¹ Wire (wir) n. 1. A usually pliable metallic strand or rod made in many lengths and diameters, sometimes clad and often electrically insulated, used chiefly for structural support or to conduct electricity.

All pending claims of this application require the guidewire to be "non-woven." Osborne '640 clearly and unambiguously discloses a guidewire which is "woven" (cf., Fig. 1 features 13 and 14; claims 1-10). More specifically, "fibers helically wound" are required per the description of the preferred embodiment and the claims of Osborne '640. The importance and criticality of the fibers helically wound is emphasized in the disclosure of the Osborne '640 patent at column 2 line 51 where it is noted that:

The arrangement of the helically wound fibers 13 and 14 is believed to be the primary influencing factors on the torqueability performance characteristics of the wire guide shaft.

Osborne '640 is clearly an unambiguously distinguished by virtue of the requirement of all claims of the present application that the guide wire be "non-woven."

Various dependent claims have been rejected by combinations of Osborne '640 in conjunction with various secondary references. The Osborne '640 primary reference is clearly and unambiguously been distinguished in the discussion above. Thus, the combinations with the secondary references fail for absence of an adequate combination. Applicants reserve the right to substantively distinguish any of the secondary references should further discussion thereof be needed.

Respectfully submitted,

Date: 5/24/04


Grady J. Frenchick
Reg. No. 29,018

058442-9191

Michael Best & Friedrich LLP
P.O. Box 1806
Madison, WI 53701-1806
Ph: (608) 283-0109 direct
Fax: (608) 283-2275

Q:\client\058442\9191\B0368020.1

2. A group of such strands bundled or twisted together as a functional unit; a cable. 3. Something resembling a wire, as in slenderness or stiffness.... The American Heritage Dictionary (1982).